REMARKS

Claims 34 and 35 are newly added. Therefore, claims 11-22 and 34-35 are pending in the application. Applicant thanks the Examiner for indicating that claims 18-22 are allowed.

Reconsideration and allowance of all claims are respectfully requested in view of the following remarks.

- Claims 11-17 stand rejected under 35 U.S.C. § 103(a) as being obvious over *Lindblom* (U.S. Patent No. 5,373,902) in view of *Juncker et al.* (U.S. Patent Publication No. 20020130552). Applicant respectfully traverses the rejection.

The claimed soil stabilizer improves over conventional oil stabilizers by uniquely providing a structure that greatly reduces bounce, which in a conventional soil stabilizer causes a rotor to be moved up and down and cut at varying depths. The claimed structure also greatly reduces wiggle and slide, which in a conventional soil stabilizer cause additional bounce, inability to move in a desired direction, and loss of control.

There would have been no motivation to have combined the *Lindblom* disclosure with the *Juncker '552* disclosure, since neither reference would have taught or suggested the improved soil stabilization operation effected by the claimed apparatus. A hypothetical artisan viewing the applied references would not have expected a problem to have existed that required an improved soil stabilization operation and structure. See, *e.g.*, In re Nomiya, 184 USPQ 607 (CCPA 1975). Specifically, the structure and operation of *Lindblom* perpetuate the conventional problems where: a) differences in compression between adjacent areas create ruts that in turn cause a soil stabilizer rotor to bounce and to have an inconsistent soil cutting depth; b) poor traction of the

soil stabilizer also causes bounce and uneven rotor cutting depth; c) sliding on hillsides and potential rollover accidents are caused by poor lateral traction and by a too-high center-of-gravity of a conventional soil stabilizer; and d) a compaction of earth in the direction of travel is aggravated in wet areas and a resistance to holes or floatation is poor (e.g., Applicant's specification, at page 1: line 30 to page 3: line 5).

Instead, the problem addressed by *Lindblom* relates to improving the accessibility of the rotor for servicing and maintenance (e.g., *Lindblom*, at col. 1: lines 44-57). The *Lindblom* reference is silent regarding any of the above-noted problems, and is silent regarding any associated structural limitations in Applicant's claims 11-17. Similarly, the problem addressed by *Juncker '552* relates to a conventional lack of supporting structure for track lugs, which causes excessive drive force to be imparted on the track lugs by the drive wheel, resulting in cracking and premature wear of the track lugs (e.g., *Juncker '552*, at ¶6). As noted in the In re Nomiya case, if there is no evidence that a person of ordinary skill in the art at the time of an applicant's invention would have expected a problem to exist at all, it is not proper to conclude that an invention which solves this problem would have been obvious to that hypothetical person. In re Nomiya, *supra*, at 612-613. "The significance of evidence that a problem was known in the prior art is, of course, that knowledge of a problem provides a reason or motivation for workers in the art to apply their skill to its solution." Id., at 613.

In our case, the ground of rejection states, "However, Juncker discloses a soil stabilizer moved and supported by a track apparatus [,] the details of which are set forth below. It would have been obvious to one having ordinary skill in the art to provide the soil stabilizer of the

Lindblom patent with the track apparatus of the Juncker patent in order to reduce the ground pressure and increase the traction of Lindblom's soil stabilizer." (Office action, at page 3). Applicant respectfully submits that the just-quoted characterization of *Juncker '552* is wrong because *Juncker '552* does not teach or suggest a soil stabilizer, at all. In addition, neither applied reference teaches or suggests any 'reducing of the ground pressure' or 'increasing of the traction of' any soil stabilizer. Thus, there would have been no motivation or suggestion to have modified the references as posited by the Examiner. The Examiner's statement of alleged motivation can only have been gleaned from Applicants' disclosure, which amounts to impermissible hindsight. MPEP § 2143 *et seq.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. Id., citing In re Vaeck, 20 USPQ2d 1438 (Fed. Cir. 1991). Since the Examiner has not provided any support for the alleged motivation, the ground of rejection does not meet the requirements of a *prima facie* case. Id. Accordingly, Applicant respectfully requests the § 103 rejection of claims 11-17 be withdrawn. Claims 12-17 are patentable at least by virtue of their respective dependencies from independent claim 11.

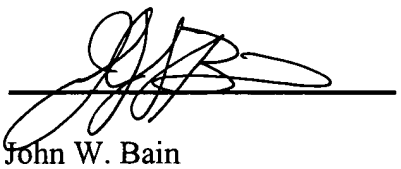
- Newly added claims 34-35 are patentable for the same reasons as just discussed for claims 11-17. See, e.g., In re Nomiya, *supra*.

Request for Interview

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly **requested to call** the undersigned at the telephone number listed below.

Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee, except for the Issue Fee, for such extension is to be charged to Deposit Account No. 10-0270.

Respectfully submitted,



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